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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/792,066

03/03/2004

Andre Soshinsky

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4207

7590 05/02/2007  
Warner-Lambert Company LLC  
201 Tabor Road  
Morris Plains, NJ 07950

EXAMINER

AHMED, HASAN SYED

ART UNIT

PAPER NUMBER

1615

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/792,066	<b>Applicant(s)</b> SOSHINSKY, ANDRE	
	<b>Examiner</b> Hasan S. Ahmed	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4 and 23, drawn to a multi-layer film composition comprising a first layer comprising a neutral polymer and a cationic ion source, and a second layer comprising an anionic polymer, classified in class 424, subclass 1.13.
- II. Claims 5-7, drawn to a multi-layer film composition comprising a first layer comprising a cationic polymer, and a second layer comprising an anionic polymer, classified in class 424, subclass 1.13.
- III. Claims 8-12, drawn to a multi-layer film composition comprising a first layer comprising a neutral polymer and an anionic or cationic ion surfactant, and a second layer comprising a neutral polymer and a water-soluble salt, classified in class 424, subclass 1.13.
- IV. Claims 13-16, drawn to a multi-layer film composition comprising a first layer comprising a neutral polymer and an anionic surfactant, and a second layer comprising a cationic polymer, classified in class 424, subclass 1.13.
- V. Claims 17-20, drawn to a film composition comprising a first layer comprising a cationic surfactant, and a second layer comprising an anionic polymer, classified in class 424, subclass 1.13.
- VI. Claim 21, drawn to a tri-layer film, classified in class 424, subclass 1.13.

VII. Claim 22, drawn to a method of manufacturing multilayer film compositions, classified in class 424, subclass 1.13.

\* \* \* \* \*

The inventions are distinct, each from the other for the following reasons:

***Groups I-VII***

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, Group I is directed to a multi-layer film composition comprising a first layer comprising a neutral polymer and a cationic ion source, and a second layer comprising an anionic polymer while Group II is directed to a multi-layer film composition comprising a first layer comprising a cationic polymer, and a second layer comprising an anionic polymer.

Inventions I and III are unrelated. In the instant case, Group I is directed to a multi-layer film composition comprising a first layer comprising a neutral polymer and a cationic ion source, and a second layer comprising an anionic polymer while Group III is directed to a multi-layer film composition comprising a first layer comprising a neutral polymer and an anionic or cationic ion surfactant, and a second layer comprising a neutral polymer and a water-soluble salt.

Inventions I and IV are unrelated. In the instant case, Group I is directed to a multi-layer film composition comprising a first layer comprising a neutral polymer and a cationic ion source, and a second layer comprising an anionic polymer while Group IV is

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directed to a multi-layer film composition comprising a first layer comprising a neutral polymer and an anionic surfactant, and a second layer comprising a cationic polymer.

Inventions I and V are unrelated. In the instant case, Group I is directed to a multi-layer film composition comprising a first layer comprising a neutral polymer and a cationic ion source, and a second layer comprising an anionic polymer while Group V is directed to a film composition comprising a first layer comprising a cationic surfactant.

Inventions I and VI are unrelated. In the instant case, Group I is directed to a multi-layer film composition while Group VI is directed to a tri-layer film.

Inventions I and VII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make another and materially different product, such as a capsule.

### ***Groups II-VII***

Inventions II and III are unrelated. In the instant case, Group II is directed to a multi-layer film composition comprising a first layer comprising a cationic polymer, and a second layer comprising an anionic polymer, while Group III is directed to a multi-layer film composition comprising a first layer comprising a neutral polymer and an anionic or cationic ion surfactant, and a second layer comprising a neutral polymer and a water-soluble salt.

Inventions II and IV are unrelated. In the instant case, Group II is directed to a multi-layer film composition comprising a first layer comprising a cationic polymer, and a second layer comprising an anionic polymer, while Group IV is directed to a multi-layer film composition comprising a first layer comprising a neutral polymer and an anionic surfactant, and a second layer comprising a cationic polymer.

Inventions II and V are unrelated. In the instant case, Group II is directed to a multi-layer film composition comprising a first layer comprising a cationic polymer, and a second layer comprising an anionic polymer, while Group V is directed to a film composition comprising a first layer comprising a cationic surfactant.

Inventions II and VI are unrelated. In the instant case, Group II is directed to a multi-layer film composition while Group VI is directed to a tri-layer film.

Inventions II and VII are related as process of making and product made. In the instant case the process as claimed can be used to make another and materially different product, such as a capsule.

### ***Groups III-VII***

Inventions III and IV are unrelated. In the instant case, Group III is directed to a multi-layer film composition comprising a first layer comprising a neutral polymer and an anionic or cationic ion surfactant, and a second layer comprising a neutral polymer and a water-soluble salt, while Group IV is directed to a multi-layer film composition comprising a first layer comprising a neutral polymer and an anionic surfactant, and a second layer comprising a cationic polymer.

Inventions III and V are unrelated. In the instant case, Group III is directed to a multi-layer film composition comprising a first layer comprising a neutral polymer and an anionic or cationic ion surfactant, and a second layer comprising a neutral polymer and a water-soluble salt, while Group V is directed to a film composition comprising a first layer comprising a cationic surfactant.

Inventions III and VI are unrelated. In the instant case, Group III is directed to a multi-layer film composition while Group VI is directed to a tri-layer film.

Inventions III and VII are related as process of making and product made. In the instant case the process as claimed can be used to make another and materially different product, such as a capsule.

#### ***Groups IV-VII***

Inventions IV and V are unrelated. In the instant case, Group IV is directed to a multi-layer film composition comprising a first layer comprising a neutral polymer and an anionic surfactant, and a second layer comprising a cationic polymer, while Group V is directed to a film composition comprising a first layer comprising a cationic surfactant.

Inventions IV and VI are unrelated. In the instant case, Group IV is directed to a multi-layer film composition while Group VI is directed to a tri-layer film.

Inventions IV and VII are related as process of making and product made. In the instant case the process as claimed can be used to make another and materially different product, such as a capsule.

***Groups V - VII***

Inventions V and VI are unrelated. In the instant case, Group V is directed to a film composition while Group VI is directed to a tri-layer film.

Inventions V and VII are related as process of making and product made. In the instant case the process as claimed can be used to make another and materially different product, such as a capsule.

***Groups VI and VII***

Inventions VI and VII are related as process of making and product made. In the instant case the process as claimed can be used to make another and materially different product, such as a capsule.

\* \* \* \* \*

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

\* \* \* \* \*



Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

\* \* \* \* \*

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

\* \* \* \* \*

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

\* \* \* \* \*

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

\* \* \* \* \*

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should Applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

☆

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hasan S. Ahmed whose telephone number is 571-272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward, can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
HUMERA N SHEIKH  
PRIMARY EXAMINER